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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,043	06/19/2002	Jean Michel Adelaide	1418-101	6579

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EXAMINER

ZANELLI, MICHAEL J

ART UNIT	PAPER NUMBER
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3661

DATE MAILED: 08/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/088,043

Applicant(s)

ADELAIDE ET AL.

Examiner

Michael J. Zanelli

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 June 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been examined. The preliminary amendment filed 3/14/02 has been entered. Claims 1-15 are pending.
2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.
3. The abstract of the disclosure is objected to because it should be narrative in nature and not contain legalese ("said"). Correction is required. See MPEP § 608.01(b).
4. The drawings are objected to because playing means "9", memory unit "18" and casing "12" are not shown in the Figures. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
5. The disclosure is objected to because of the following informalities:
 - A. [0029]- no playing means "9" shown.
 - B. [0032]- no casing "12" shown.
 - C. [0047]- no memory unit "18" shown.
 - D. [0055]- reading means labeled "7" not "4".
6. Claims 1-15 are objected to because of the following informalities:
 - A. As per claim 1, at line 8 "n" should be --in--.
 - B. All claims depending from an objected base claim are also objected to as containing the same deficiencies.
7. Claim 12 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the supply of information corresponding to a given geographic

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location, does not reasonably provide enablement for an additional memory unit (26) *for storing information intended for providing statistics* (emphasis added). The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with this claim. In particular, the specification lacks any disclosure or suggestion as to what the statistics stored in the memory unit pertain to and/or how they are used by the disclosed invention.

8. Claims 1-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. As per claim 1, the scope of the claim is indefinite because it recites both a broad limitation (“information”) followed by a narrow limitation (“notably for tourism”). It is unclear which limitation governs the scope of the claim. Further, the claim is unclear as to what is meant by “*so-called* positioning information”. Either the information is positioning information or it is not. Additionally, the claim is unclear at line 13 as to what is being referred to as “them”. Also not comments above with regards to “*so-called* information selected”.

B. As per claim 2, not comments above regarding use of the phrase “so-called”.

C. As per claim 4, the claim is unclear as to what is meant by “permanently”. It appears that the word “continuously” would be more appropriate to describe constant scanning of the positioning information.

D. As per claim 5, the claim is unclear as to what is being referred to as “them”.

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E. As per claims 7, 8 and 11, the claims are indefinite because of the use of the alternative “and/or”. The examiner suggests using the phrase “at least one of ... and ...”.

F. All claims depending from a rejected base claim are also rejected as containing the same deficiencies.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-5, 8 and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Schaphorst (5,767,795).

A. As per claim 1, Schaphorst discloses a mobile device (Figure) for supplying information to a user. The device includes a storage means (5) for storing information corresponding to geographic locations in which the data is arranged in sectors (col. 4, lines 9-21); a tracking means (1) for providing positioning information; processing means (3) for reading information from the storage means based on the positioning information (col. 4, lines 15-21); reading means (col. 1, line 46) for reading information from the storage means based on instruction from the processing means;

and playing means (15,7) for transmitting the information to a user. As noted in the abstract, the disclosed invention may be used as an electronic tour guide.

B. As per claim 2, as above wherein the storage means may store narratives associated with a fixed location or include comments regarding an attraction relative to the current location (col. 4, lines 38-49). Means are provided to allow a user to customize the device to control the content of the information outputted (col. 5, lines 4-15) or to enable the user to query the storage device directly for information (col. 6, lines 15-20, 31-35).

C. As per claim 3, as above wherein the storage means is removable (i.e., CD-ROM; magnetic tape, etc.)(col. 2, lines 54-58; col. 4, lines 50-55).

D. As per claim 4, as above wherein the tracking means continuously provides location information used to access the stored information (col. 5, lines 51-62).

E. As per claim 5, as above wherein the information is accessed from the storage means automatically as soon as position is provided by the tracking means (col. 6, lines 23-26).

F. As per claim 8, as above wherein the tracking means is at least a satellite positioning module (Figure:1).

G. As per claims 13-15, as above wherein assistance means (11) is provided to allow the user to independently access information from the storage means as well as to connect to an external communication network (9)(col. 5, lines 21-51; col. 6, lines 15-20, 31-35).

11. Claims 1-5, 8, 9, 11, 13 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by Jamison et al. (6,085,148).

A. As per claim 1, Jamison discloses a device for providing information to a user based on geographical location information (Abs.). As shown in Fig. 2, the device includes a storage means (52) containing location specific information in which the information is stored on tracks or information segments (col. 7, line 63 to col. 8, line 11); tracking means (46); processing means (50); reading means (75c); and playing means (48). The processing means controls the reading means to access information stored on a track of the storage means based on location information provided by the tracking means (Abs.). As noted in col. 1, lines 12-15, the device may be used to automatically provide touring information about specific locations (see also col. 13, lines 34-37).

B. As per claim 2, as above wherein means (76) are provided to allow a user to customize the device to control the content of the information provided (col. 8, lines 37-42) or to enable the user to query the storage device directly for information (col. 8, lines 42-50).

C. As per claim 3, as above wherein the storage means is removable (i.e., CD-ROM; floppy disk, etc.)(col. 8, lines 20-36).

D. As per claim 4, as above wherein the tracking means continuously provides location information used to access the stored information (col. 5, lines 57-61).

E. As per claim 5, as above wherein the information is accessed from the storage means automatically as soon as position is provided by the tracking means (col. 5, lines 48-65).

F. As per claims 8 and 9, as above wherein the device may receive location information from either a satellite or ground beacon positioning module (col. 10, lines 39-41).

G. As per claim 11, as above wherein the user may at least pause the delivery of the information (col. 8, lines 42-45).

H. As per claims 13 and 14, as above wherein the user may use input means to control the content and manner in which the information is delivered (col. 8, lines 37-50).

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a

later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

14. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jamison in view of Ashby et al. (6,081,803).

A. Jamison is applied as above. The claimed invention differs in that an assistance means comprises a connection to an external information communication network.

Ashby discloses providing information associated with a geographical location similar to Jamison except provision is made to allow a user to access information stored external to the device (col. 5, lines 29-35). Ashby discloses that some of the information can be stored on external devices accessed through a communications link. One of ordinary skill in the art would have found it obvious to incorporate the teachings of Ashby in the device of Jamison because it would have reduced the size of the internal storage means (Ashby, col. 6, lines 13-17; 44-47).

15. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schaphorst or Jamison in view of Ichikawa (6,351,707).

A. Schaphorst and Jamison are applied as above. The claimed invention differs in that a memory unit is provided for storing information intended for providing statistics. As noted above in paragraph 7, the specification is silent as to the nature of the statistics. However, it was well-known in the art that statistics are used in generating route information of the type that could be associated with the "tours" utilized by Schaphorst and Jamison. For example, Ichikawa discloses a route calculation method which utilizes cost statistics to generate a route between at least two points (Abs.; Fig.

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8). One of ordinary skill in the art would have recognized that such statistical information would have been utilized in generating "tour" routes of the type exemplified by Schaphorst and Jamison.

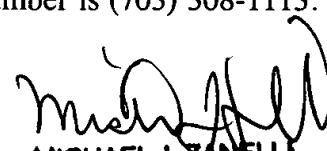
16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited patents represent the general state of the art.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael J. Zanelli whose telephone number is (703) 305-9756. The examiner can normally be reached on Monday-Thursday 5:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William A. Cuchlinski can be reached on (703) 308-3873. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

/mjz
August 7, 2003


MICHAEL J. ZANELLI
PRIMARY EXAMINER